



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

09/683,454

01/02/2002

John S. Fisher

1139.16

6289

21901

7590

05/05/2004

SMITH & HOPEN PA  
15950 BAY VISTA DRIVE  
SUITE 220  
CLEARWATER, FL 33760

EXAMINER

MCCROSKY, DAVID J

ART UNIT

PAPER NUMBER

3736

DATE MAILED: 05/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/683,454

Applicant(s)

FISHER ET AL.

Examiner

David J. McCrosky

Art Unit

3736

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 February 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-4,8-10 and 15-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4,8-10 and 15-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

An unsigned amendment was submitted on February 16, 2004. However, a signed copy of the amendment was received on April 21, 2004 and placed in the file.

#### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-3, 8-12 and 15-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bonnell et al in view of Alberico and Turturro et al. Bonnell et al teach a biopsy tool comprising a hollow needle (22) with a slot (28) on its distal end. An inner tube (32) having a flat distal end rotates within the lumen of the hollow needle (22). Helically shaped sharp peripheral edges (34) line the opening of the inner tube. Rotation means includes a motor (54) in a hand-held housing (50). See Figs. 1, 3, 4, 6, and 9. As illustrated in Figure 1, a vacuum source is provided. Bonnell et al do not teach a needle with a pointed distal end. However, Alberico discloses a biopsy device having a hollow needle with a pointed distal end. An inner tube rotates inside the hollow needle. See paragraphs 13-16. While Bonnell et al disclose delivering material for analysis (col. 4, ll. 3-8 and col. 5, ll. 12-14), a receptacle and filter are not taught. Turturro et al teach a biopsy tool having irrigation (24, 25) and aspiration means (26, 27). See Fig. 1 and col. 9, l. 56 to col. 10, l. 41. A receptacle (42), positioned between a vacuum source (640) and a biopsy means (13), has a removable filter trap. See Fig. 33, col. 4, ll. 4-8 and ll. 35-39 and col. 22, ll. 4-12. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the needle of

Art Unit: 3736

Bonnell et al with a pointed distal end, as taught by Alberico, to minimize tissue damage during insertion and to modify the biopsy tool of Bonnell et al and Alberico with the receptacle and filter trap of Turturro et al to aid in collecting the sample.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bonnell et al in view of Alberico and Turturro et al as applied to claim 1 above. Bonnell et al, Alberico and Turturro et al disclose a biopsy tool as recited for claim 1. The combination does not disclose an inner tube opening in a diamond configuration. It would have been an obvious matter of design choice to modify the opening of Bonnell et al, Alberico and Turturro et al by providing a diamond configuration since Applicant has not disclosed that using the configuration solves any stated problem or is for any particular purpose and it appears that the apparatus would perform equally well with any configuration, which aids in the collection of severed material.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-4, 8-10 and 15-18 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Trott discloses a rotary biopsy tool with an inner tube having a flat distal end.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

Art Unit: 3736

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David J. McCrosky whose telephone number is 703-305-1331. The examiner can normally be reached on Mon-Fri 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mary Beth Jones can be reached on 703-308-3400. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3736

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DJM

*Mary Beth Jones*  
*Acting SPE*  
*Art 3736*